

Remarks/Arguments

The following remarks address the Examiner's comments in the order they appear in the Office Action.

**A. The Claims are Not Anticipated by the Harvey Patent**

The Examiner first rejected claims 1-4, 6, 7, 9-16, 18-22, 24-31, 33-36 and 39-40 under 35 U.S.C. § 102(e) as anticipated by U.S. Patent No. 6,519,629 to Harvey et al. ("Harvey patent"). To anticipate a claim, a single prior art reference must disclose all the elements of the claim as arranged therein. *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226 (Fed. Cir. 1989). Anticipation requires identity between the claim and the prior art reference. *Glaverbel S.A. v. Northlake Mkt'g & Supp.*, 45 F.3d 1550 (Fed. Cir. 1995). Applicant respectfully submits that the foregoing claims are not anticipated by the Harvey patent.

**1. Claims 1-4 Are Not Anticipated**

Applicant believes that the Harvey patent does not disclose the element of *an evolving story line* contained in claim 1.

The Harvey patent describes a system (Information and Application Distribution System – IADS) that allows users to develop, customize and deploy online communities for like-minded individuals. The communities have functionalities such as chat rooms, instant messaging, mailing lists, classifieds, multi-user games, subscriptions and online stores. Once a community is created, the system allows the creator to send out email invitations to potential users asking them to join. If the potential users chooses to join, they must register and download the community applications to the local hard drive on

their personal computer. Once this is complete, the user can join in a chat room, participate in instant messaging, invite other participants to join the community, play games against other members, purchase goods and services, etc.

As such, the Harvey patent primarily focuses on the steps preceding the user being in a position to play a game. Indeed, the Harvey patent provides very little disclosure as to what the contemplated game actually entails. The only description of games in the Harvey patent are cursory references to "computer games" and "game cards", (23:34-57), and "virtual value reallocation" games where score is kept and winners and losers identified. (27:62-28:18.)

In sharp contrast, the system and method of the current invention involves the interaction between a story line and a participant, wherein the story line evolves or is furthered by the participant's interaction. Furthermore, the games that are mentioned in cursory fashion in the Harvey patent simply do not disclose the evolving story line of the current invention in the first place. As such, claims 1-4 are not anticipated by Harvey for this reason.

Applicant also believes that the Harvey patent does not disclose the element of a *message sent by the system manager to the participant that conveys information of the story line* element contained in claim 1. The Examiner suggests that the email invitation disclosed at Col. 24, lines 25-45, ("24:25-45"), of the Harvey patent discloses this element. However, this email invitation sent by the Central Controller Module to the user is sent *prior to* the user interacting with any type of game. As shown in Step 405 of Fig 7 (referenced in the passage cited by the Examiner), this email "invokes connection to the central controller." By receiving this email, the user in the Harvey patent is not

participating in a game. Furthermore, the email does not convey information about an evolving story line. Rather, the user is just joining a community to be in position to play some non-specified game. This is confirmed by the specification of the Harvey patent:

The email preferably indicates (through the message component) that the purpose of the email is to allow the recipient to join a community and participate in multiple player game play using IADS 100. (Col. 24, lines 44-47.)

In sharp contrast, the message sent by the system manager of claim 1 of the current invention conveys information of the story line with which the participant is already interacting. That the participant is already interacting with the story line at the time the message is sent is shown by the preamble of claim 1 which recites "[a] system wherein a participant *interacts* with an evolving story line." (Emphasis added.) The passage from the Harvey patent cited by the Examiner does not disclose this.

Applicant also believes that the Harvey patent does not disclose the element of a *response sent by the participant to the system manager that responds to the message* contained in claim 1. The Examiner again cites Col. 24, lines 25-45 of the Harvey patent as disclosing this element, but it appears that the Examiner intended to again cite Col 24, lines 47-55. These lines describe the user in the Harvey patent accepting the email invitation as shown in step 410 of Fig. 7.

However, as with the email sent to the user in step 405 of Fig. 7, the acceptance of the email in step 410 occurs merely so that the user may join a community and occurs prior to any contact with a game. In sharp contrast, the response sent by the participant in the current invention occurs while the participant is already interacting with an evolving story line. The Harvey patent does not disclose this.

Applicant also believes that the Harvey patent does not disclose the element of a *subsequent message sent by the system manager that furthers the story line based on the participant's response* contained in claim 1. The Examiner cited Col. 24, line 65 - Col. 25, line 5. In so doing, the examiner appears to suggest that the connection between the user and the Central Controller Module, the registration by the user and the downloading of the client application is "a subsequent message sent by the system manager that furthers the story line..." However, this connection, registration and subsequent downloading of a client application are performed prior to the user plays a game. These steps occur in Step 415 of Fig 7 which is well before step 440 of wherein the user participated in a game.

In sharp contrast, the sequence of claim 1 describes that the subsequent message sent by the system manager that furthers the story line is sent while the participant is interacting with the evolving story line. Harvey do not describe this.

Applicant does not believe that the disclosure of the Harvey patent requires any amendment to claim 1. But for purposes of clarifying the current invention, Applicant has amended this claim to more particularly point out that the message, the response and the subsequent message are sent while the participant is already interacting with the evolving story line.

Applicant believes that claim 1 as submitted is not anticipated by the Harvey patent, and that amended claim 1 further confirms this. Because claims 2-4 depend from claim 1 and thus contain all its elements, these claims are also not anticipated by the Harvey patent.

Claims 2-4 are also not anticipated by Harvey because the e-mail (claim 2), hyperlink (claim 3) and web page (claim 4) recited by these claims are not disclosed by the Harvey patent. The Harvey patent's references to these types of items are not in the context of an evolving story line.

## **2. Claims 6, 7, 9-16, 18-20 Are Not Anticipated**

Applicant believes that the Harvey patent does not disclose the element of an *interactive story line having a plurality of routes, wherein a participant assumes the role of a character in the story line, interacts with the story line and affects the progress of the story line* contained in claim 6.

The Examiner generally cited figure 7 as disclosing this element. However, the majority of figure 7 describes how a user joins a community, registers and downloads the community and game application. Only after these steps is the user in a position to play some type of non-specified game. Indeed, the step of the "user participat[ing] in coordinated game" is not set forth until step 440. Even then, the "coordinated game" is not described in figure 7 or in the specification of the Harvey patent. As such, the Harvey patent in no way discloses an "interactive story line having a plurality of routes, wherein a participant assumes the role of a character in the story line" as in claim 6.

The fact that the Harvey patent does not disclose one element is sufficient to overcome an anticipation rejection. However, Applicant also believes that the Harvey patent does not disclose other elements of claim 6.

For example, the Harvey patent does not disclose the element of *a response by the participant to the message that represents how the participant's character interacts with the story line and that is provided to the system manager*. The Examiner cites Col.

27, lines 40-50 of the Harvey patent as disclosing this element, but that passage only discloses that "[p]articular files, characters and game elements may also be cached locally at client 110 for rapid access during game play." (27:47-49.) This discloses nothing about a character interacting with a story line.

To the extent that the Examiner intended to refer to Col. 24, lines 45-55, this passage only describes how the user in the Harvey patent accepts the email invitation as shown in step 410 of Fig. 7. This occurs prior to any game and does not disclose a character's interaction with a story line.

Applicant also believes that the Harvey patent does not disclose the element of *wherein the system manager progresses the story line along a routed based on the participant's response*. The Examiner cited Col. 27, lines 40-50. This passage describes how the Central Controller Module instructs the user to download game applications on the user's local hard drive, as well as additional files such as graphics, art work and audio files necessary for game play. However, this all occurs prior to the game in the Harvey patent, and in reality, occurs so that the user has the appropriate files in order to play a game.

In sharp contrast, the system manager of claim 6 progresses the story line that is already occurring and with which the participant is already interacting, because it is the participant's response that serves to progress the story line. The system manager is not "setting up" a story line.

Applicant believes that claim 6 as submitted is not anticipated by the Harvey. Because claims 7, 9-16 and 18-20 depend from claim 6 and thus contain all its elements, these claims are also not anticipated by the Harvey patent.

Claim 7 is also not anticipated by the Harvey patent's disclosure at Col. 25, lines 5-20 as cited by the Examiner. This passage only refers to the launching of some non-specified game, and not subsequent messages and responses that occur as the story line progresses.

Claim 9 is also not anticipated by the Harvey patent's disclosure at Col. 26, lines 5-15 as cited by the Examiner. This passage only refers to multiple players playing a game and awarding prizes, etc. This does not disclose the additional subsequent messages and responses of claim 9.

Claim 10 is also not anticipated by the Harvey patent's disclosure at Col. 31, lines 25-40 as cited by the Examiner. The items listed in this passage disclosing nothing about how a story line progresses by messages.

Claim 11 is also not anticipated by the Harvey patent's disclosure at Col. 27, lines 20-30 as cited by the Examiner. This passage refers only to the steps involved with a user receiving a game. It does not disclose how a story line progresses.

Claim 12 is also not anticipated by the Harvey patent's disclosure at Col. 5, lines 55-67 and Col. 27 lines 40-50 as cited by the Examiner. These passages do not disclose how a story line progresses.

Claim 13 is also not anticipated by the Harvey patent's disclosure at Col. 12, lines 40-55 as cited by the Examiner. This passage only discloses that users in a community may have personalized profiles. This does not disclose how a message provided during a story line may be personalized.

Claim 14 is also not anticipated by the Harvey patent's disclosure at Col. 26, lines 5-15 as cited by the Examiner. This passage discloses only that users may participate

in coordinated game play. However, this does not disclose a message that seeks a response.

Claim 15 is also not anticipated by the Harvey patent's disclosure at Col. 12, lines 40-55 as cited by the Examiner because the reference to a server still does not disclose the server of claim 15 that manages a story line.

Claim 16 is also not anticipated by the Harvey patent's disclosure at Col. 6, lines 40-50 as cited by the Examiner because the reference to the internet still does not disclose how the internet is used in the story line of claim 16.

Claim 18 is also not anticipated by the Harvey patent's disclosure at Col. 8, lines 35-45 as cited by the Examiner because the reference to different community categories does not disclose a story line based on a certain theme as in claim 18.

Claim 19 is also not anticipated by the Harvey patent's disclosure at Col. 12, lines 40-55 and Col. 24, lines 10-25 for the same reasons expressed with claim 13.

Claim 20 is also not anticipated by the Harvey patent's disclosure at Col. 23, lines 40-55 as cited by the Examiner because the disclosure of "games cards" does not disclose the use of reality and fiction.

### **3. Claim 21 Is Not Anticipated**

Applicant believes that the Harvey patent does not anticipate claim 21 because the Harvey patent does not disclose the element of *an interactive story line having a plurality of routes, wherein a participant assumes the role of a character in the story line, interacts with the story line and affects the progress of the story line* contained in claim 21 for the same reasons discussed with claim 6. The Examiner also cited Col. 26, lines 5-15. However, this passage only refers to multiple players participating in coordinated



game play. However, this also does not disclose the interactive story line having a plurality of routes.

Applicant also believes that the Harvey patent does not disclose the steps of *receiving a response by the participant to the message that represents how the participant's character interacts with the story line and progressing the story line along a route based on the participant's response* for reasons similar to those discussed in connection with claim 6.

Applicant believes that claim 21 as submitted is not anticipated by the Harvey patent. Because claims 22, 24-31 and 33-35 depend from claim 21 and thus contain all its elements, these claims are also not anticipated by the Harvey patent. These dependent claims are also not anticipated by the Harvey patent for reasons similar to those discussed in connection with the claims depending from claim 6.

#### **4. Claim 36 Is Not Anticipated**

Applicant believes that the Harvey patent does not anticipate claim 36 because the Harvey patent does not disclose the element of *an interactive story line having a plurality of routes, wherein a participant assumes the role of a character in the story line, interacts with the story line and affects the progress of the story line* contained in claim 36 for the same reasons discussed with claim 21.

The fact that the Harvey patent does not disclose one element is sufficient to overcome an anticipation rejection. However, Applicant also believes that the Harvey patent does not disclose other elements of claim 36.

For example, the Harvey patent does not disclose the element of *an informational message from the system manager to the participant that provides*

*information about the story line but that does not seek a response by the participant* contained in claim 36. The Examiner cites to Col. 15, lines 60-67 of the Harvey patent and comments that "a user can decide not to participate."

However, this passage cited by the Examiner describes how a user may decline the invitation to join the community by stopping the download of a client application for a community. The Central Controller Module then records into a database that the user declined the invitation. Applicant believes that it is inaccurate to equate the user declining an invitation in the Harvey patent to the informational message that does not seek a response of claim 36. This is because by declining the invitation, the user in the Harvey patent has still "press[ed] a button to cancel an install," (15:63-64), and has thus responded to the invitation. This is unlike the informational message of claim 36 that does not seek a response.

The Harvey patent also does not disclose *a response by the participant to the response-seeking message that represents how the participant's character interacts with the story line and that is provided to the system manager and wherein the system manager progresses the story line along a route based on the participant's response* for the same reasons as discussed in connection with claim 6.

#### **5. Claim 39 Is Not Anticipated**

Applicant believes that the Harvey patent does not disclose the element of an *interactive story line, wherein a participant assumes the role of a character in the story line, interacts with the story line and affects the progress of the story line* contained in claim 39.

The Examiner generally cited figure 7 as disclosing this element. However, the majority of figure 7 describes how a user joins a community, registers and downloads the community and game application. Only after these steps is the user in a position to play some type of non-specified game. Indeed, the step of the "user participat[ing] in coordinated game" is not set forth until step 440. Even then, the "coordinated game" is not described in figure 7 or in the specification of the Harvey patent. As such, the Harvey patent in no way discloses an "interactive story line, wherein a participant assumes the role of a character in the story line" as in claim 39.

The fact that the Harvey patent does not disclose one element is sufficient to overcome an anticipation rejection. However, Applicant also believes that the Harvey patent does not disclose other elements of claim 39.

For example, the Harvey patent does not disclose the element of *a system manager that stores information about the story line, including information about a plurality of possible routes that the story line may take as a result of the participant's interaction with the story line* as contained in claim 39. The Examiner Col. 6, lines 20-40 of the Harvey patent as disclosing this element. However, that passage only provides a general description that a server may communicate with various data storage modules. This provides no disclosure about the storage of information of a plurality of possible routes of a story line.

The Harvey patent also does not disclose the element of *a plurality of responses by the participant to the response-seeking messages that are provided to the system manager, the plurality of responses representing how the participant's character interacts with the story line* in claim 39 or the reasons discussed in connection with

claim 6. But in addition to the reasons discussed for claim 6, the Harvey patent does not disclose the plurality of such messages and responses.

The Harvey patent also does not disclose the element of *wherein the system manager progresses the story line along one of the plurality of possible routes stored by the system manger, the route being depending on at least some of the participant's responses* contained in claim 39 for the same reasons as discussed in connection with claim 6. But in addition to the reasons discussed for claim 6, the Harvey patent does not disclose the plurality of such responses. The Examiner cited Col. 25, lines 5-15, but this passage regarding coordinated game play does not disclose this element.

**6. Claim 40 Is Not Anticipated**

Claim 40 is not anticipated for the same reasons as expressed with claim 39.

**B. The Claims are Not Rendered Obvious the Harvey and Ellis Patents**

The Examiner rejected claims 5, 8, 17, 23, 32, 37 and 38 under 35 U.S.C. § 103 as obvious in view of the Harvey patent and U.S. Patent No. 6,357,043 to Ellis et al ("Ellis patent"). Applicant respectfully submits that to the extent a combination of these references is appropriate, the foregoing claims are not rendered obvious thereby.

**1. Claims 5, 8, 17 and 23 Are Not Obvious**

In view of the foregoing comments on the § 102 rejection, Applicant respectfully submits that the Examiner's statement that "Harvey teaches all the limitations" of the various claims to support the § 103 rejection, is incorrect. Accordingly, all the elements of the independent claims on which claims 5, 8, 17, 23 and 38 depend are not disclosed

by the Harvey patent, and a combination of the Harvey and Ellis patents do not render these claims obvious.

Furthermore, the Ellis patent relates to a television set top box that provides a television guide to programming and other related functions. Applicant submits that the subject matter of the Ellis patent is not related to that of the Harvey patent so these two patents should not be combined. Accordingly, the pending claims are not obvious based on a combination thereof.

Even if combined, the Ellis patent does not add subject matter to the Harvey patent that would render these claims obvious. The Ellis patent describes a television set top box that displays an electronic television program guide onto the user's television screen. The guide is controlled using a remote control. The program guide allows users to navigate and view program information on their television screens. For example, the program guide allows the user to view one program while at the same time view the program schedule information for another program. It also allows the user to view information regarding products relating to a particular program, and to purchase these products by pushing a button on the remote control. Additionally, it allows the user to view promotional information for upcoming programming and the applicable billing information that coincides with this programming. As well, it allows the user to create passwords that must be used when ordering premium service channels, products relating to a show, and pay-per-view programming. The program guide is able to display both video and guide information on the screen at once by employing techniques such as overlaying and split screens. However, these functions do not relate to the claimed subject matter as to render the claims obvious.

Accordingly, the Ellis patent does not add subject matter to the Harvey patent so as to render claims 5, 8, 17, 23 and 32 obvious.

## **2. Claims 37 and 38 Are Not Obvious**

As discussed above in connection with the Examiner's § 102 rejection of claim 36, the Harvey patent does not disclose the element of *an interactive story line having a plurality of routes, wherein a participant assumes the role of a character in the story line, interacts with the story line and affects the progress of the story line*. The same reasons apply to claim 37.

For the same reasons, the Harvey patent also does not disclose *a system manager that stores information about the story line, including information about a plurality of possible routes that the story line may take as a result of the participant's interaction with the story line*. The Ellis patent adds nothing to the Harvey patent in this regard.

The Harvey patent also does not disclose *a response by the participant to the message that represents how the participant's character interacts with the story line and that is provided to the system manager* for the reasons discussed with claim 6. The Ellis patent adds nothing to the Harvey patent in this regard.

The Examiner appears to concede that the Harvey patent does not disclose *a timer that notes when the message is sent to the participant, when the participant reviews the message or when the participant responds to the message*. With respect to the timer discussed in the Ellis patent, the Examiner suggests that the Purchase Code Verification screen time-out disclosed at Col. 26, lines 5-10 suggests this element.

Ellis describes an electronic television program guide in the form of a television top box. The program guide allows the user to set a password on the set top box that must be used when ordering premium service channels, related products or pay-per-view programming. If a user requests to order such services, products or programs, a Purchase Code Verify screen will appear asking for the password. "If the correct purchase code is not entered, the microprocessor will take no further action, and the Purchase Code Verify screen will remain displayed waiting for input. If no action is taken within a predetermined time-out period, the Purchase Code Verify screen will be removed." (Col 26, lines 5-10.).

In sharp contrast, the current invention does not use a "time-out", but uses a timer to enhance the realism of the interactive story line. An example is described on page 56 of the current invention's specification:

The length of time X may be programmed and may be initiated and measured by timer 7 so that system manager 2 sends email 602 and email 604 at a time that fits into the story line. For example, if email 600 were email 534 in Figure 13, wait time X could be a long enough time to allow the participant to check the online voice mail 530.

Having the system progress the story line at a rate that more closely resembles reality enhances the realism of the interactive story line.

In addition, a time-out system described in the examiner's remarks to Claim 5 would not note when the participant has "responded" to the message as is stated in claim 37 of the current invention. By definition, once a system has timed-out, the participant cannot respond to the system, thus the system cannot note when the participant responds. In sharp contrast, the current invention notes when the participant

responds to a message in order to wait the appropriate amount of time before sending the next message.

The Harvey patent also does not disclose the element of *wherein the system manager progresses the story line along a route by sending a subsequent message to the participant, the subsequent message having content based on the participant's response, and being sent a certain time after the message was sent to the participant, a certain time after the participant reviewed the message, or a certain time after the participant responded to the message* for the reasons discussed with claims 6 and 40.

The Ellis patent adds nothing to the Harvey patent in this regard.

In sum, the combination of the Harvey and Ellis patents do not render claim 37 obvious. For similar reasons, claim 38 is also not rendered obvious by this combination.



Conclusion

For all the foregoing, Applicant respectfully submits that the pending claims are in allowable form. Should the Examiner have any questions, the undersigned may be contacted at (213) 243-2864.

Respectfully submitted,

JONES DAY

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